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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,159	08/07/2003	Ernest R. Chacon	13710-4001	3580
34313 7590 04/13/2007 ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558			EXAMINER CHU, HELEN OK	
			ART UNIT	PAPER NUMBER
			1745	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/638,159

Applicant(s)

CHACON, ERNEST R.

Examiner

Helen O. Chu

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Applicant's Amendments have been received on March 21, 2006. Claims 7-22 are amended.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 21, 2007 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation "a first and said second sleeve being in a non-sealed relationship with each other" is considered new matter because the original specification does not support this term. The only recitation it does support is the sleeves are "not completely sealed, instead the closed end each defines an air hole." Refer to page 9, Paragraph 24)

6. Claims 14, 16, 18, 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation "immediate retrieval" is considered new matter because the original specification does not support this term or reasonable convey to one of ordinary skill at the time the invention was made to convey what is meant by "immediate retrieval."

7. The rejections under 35 U.S.C 112, second paragraph on claims 7, 8 and 14-17 are withdrawn because Applicant has amended the claims

8. The rejections under 35 U.S.C 112, second paragraph on claims 13 and 22 are withdrawn because the Applicant has amended the claims.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 14, 16, 18, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "immediate removal" is unclear to the Examiner. Is waiting for one second or an hour or a decade before removing the batteries from the battery storage apparatus considered immediate removal?

Appropriate corrections are required.

11. Claims 13 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "accessible to the user" is unclear to the Examiner. Unscrewing, unbinding, breaking, opening the sleeves would make the apparatus accessible to the user. Appropriate corrections are required.

12. Claims depending from independent claims rejected under 35 U.S.C. 112, first and second paragraph are also rejected for the same reasons.

13. To the extent the claims are understood in view of 35 U.S.C 112 rejections above, note the following prior art rejections.

Claims Analysis

14. The structures of the claim limitation are given patentable weight, however, the functional claim language is not given patentable weight. Some examples of functional claim language includes:

Claims 9, 10, 14 and 18 recite "is adapted to substantially prevent conductive items from contacting the terminals on the battery."

15. For purposes of compact prosecution, "non-sealable relationship" would be interpreted by the Examiner as being not completely sealed because the sleeve has air holes.

Claim Rejections - 35 USC § 102

16. The rejections under 35 U.S.C 102(b), on claims 7-12, 14-21, as anticipated by Takeno et al. are withdrawn because Applicants have amended the claims.

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 7-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeno et al. (US Patent 6,428,925).

In regard to claims 7, 8, 13-17 and 22, the Takeno et al. reference illustrates a battery storage apparatus with polycarbonate (Applicant's material for non-conductivity; Column 6, Lines 22-23) first and second sleeves which have a terminal end on one end and opened on the other end (Figure 9). The sleeves comprise of two cavities (Figure 6), which are closed on one end and opened on the other (Figure 6). The Takeno et al. reference also illustrates the length of the bottom sleeve is approximately the length of the exposed batteries and the length of the top sleeve is shorter than length of the batteries (Figure 1, Column 4, lines 15-28). The Takeno et al. reference discloses that

the battery case may be made in half as each battery cell and a battery pack may be constructed using a lid that has the same shape as the case. Furthermore, at the onset of putting the first and second sleeves together there is no bonding or nails put together and is accessible to a user.

In regards to claims 9,10, 18, 19, the Takeno et al discloses air apertures that pass through the first and second sleeve (Figure 2, Component 6; Figure 9, Component 44; Column 5, Lines 11-19). The diameter of the holes are small enough that would allow any conductive items bigger then the diameter of the hole from penetrating inside the hole. Furthermore, the Takeno et al. reference discloses that a series of holes (Figure 7, Component 7a) which can functions the same as the hollow diameter can be formed along the inside of the inner wall portion of the case (Column 5-6, lines 64-5). These smaller holes can substantially prevent conductive items bigger in diameter then the apertures from contacting the inside of the battery and the terminals

In regard to claims 11, 12, 20, 21, the Takeno et al. further illustrates in Figure 3 that the diameter of the battery terminal (Component 21; Column 11, lines 4-5) is larger than the diameter of the air aperture (Component 6).

19. Claims 7, 8, 13, 15, 17, 22 are rejected under 35 U.S.C. 102(b) as being unpatentable over Nishiyama et al. (US Patent 6,174,618).

The Nishiyama et al. reference discloses a battery holder made of ABS resin (Applicant's material for non-conductivity; Column 3, Lines 51) first and second sleeves, which have a terminal end and opened on the other end (Figure 8). The Nishiyama et al illustrates the diameter of the air apertures that pass through the first and second sleeve

(Figure 1, Component 2d) are smaller than the diameters of the battery terminals (Figure 1, Component 2b). Though, the Nishiyama et al. reference disclose the claimed invention except for the length of the first sleeve to be being shorter than the length of the battery and the second sleeve being less than the length of the exposed end of the battery

Claim Rejections - 35 USC § 103

20. The rejections under 35 U.S.C 103(a), on claims 7-12, as unpatentable by Nishiyama et al. are withdrawn because Applicant amended the claims.

Response to Arguments

21. Applicant's arguments filed March 21, 2007 have been fully considered but they are not persuasive.

Applicant's principal arguments are:

A). *There are no screws disclosed in Takeno et al.; instead, the specification recites numerous times that the two "sleeves" are sealed together, inherently implying the batteries are not meant to be accessible at all. See, e.g., Col. 4, lines 47-53; Col. 5, line 4 and line 62 ("bonded to each other"). This is different than amended Claims 7-12 and 14-17, which require that the sleeves not be sealed at all with the added language: "said first non-conductive sleeve and said second non- conductive sleeve being in a non-sealed relationship with each other."*

- B) *Claims 14 and 16 have only one sleeve, in which case it would not be sealed since the sleeve has an open end to insert or retrieve the battery.*
- C) *Claim 17 has two sleeves, but already makes clear that the second sleeve is shorter than the exposed end of the battery inserted in the first sleeve, and therefore the two sleeves cannot be sealed when they are so far apart.*
- D) *Amended Claims 9 and 10, and 11-12, require air apertures in the sleeves at the terminal end themselves, given that the sleeves are meant to fit the battery snuggly unlike in Takeno et al., where the figures show space between the batteries in the case. All independent Claims (Claims 7, 8, 14 and 15) have been amended to reflect that the sleeves are "adapted to snugly fit" over the batteries. Moreover, amended Claims 9 and 10 illustrate that the air apertures are "adapted to substantially prevent conductive items from contacting the terminals on said battery." Claims 11-12 and 20-21 require that the aperture have "a diameter smaller than a diameter of a battery terminal, thereby impeding contact with a battery terminal." These limitations are not disclosed in Takeno et al. Takeno is exactly the opposite of what is claimed because the battery terminals in Takeno et al. are purposefully exposed so that "the electrode leads are exposed for external connection."*
- E) *Nishiyama et al., however, teaches away from what the Examiner explains as the basis for the rejection*

In response to Applicant's principal arguments, please consider the following.

A) Please refer to new matter rejection under 35 U.S.C 112, first paragraph above.

B) Claims 14 and 16 states "comprising" which incorporates a lot more than it is claimed, though only one sleeve was claimed it does not limit the invention to have only one sleeve.

C) Claim 17 states there are two sleeves; a first sleeve and a second sleeve.

There is no order in which how these sleeves are fitted on the battery, the Examiner can interpret this claim as a battery with an exposed portion where the second sleeve fits snugly to the exposed portion (the exposed portion is interpreted in this case to include the entire body of the battery) where the second sleeves length is shorter than the exposed portion and then the first sleeve being shorter than the length of the battery is fitted on. This interpretation makes claim 17 and 7 the same invention.

(D) It seems to the Examiner that the batteries are fitted snugly in the Taneko et al. reference apparatus. If Applicants feel that the batteries are not able to fit "snuggly" then the Examiner welcomes the Applicants to prove that that the Taneko et al. reference is not capable of this feature. In regard to claims 9 and 10, it is noted that claims 9 and 10 have "intended use" language and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Applicant's arguments with respect to

claims 11-12 and 20-21 have been considered but are moot in view of the new ground(s) of rejection.

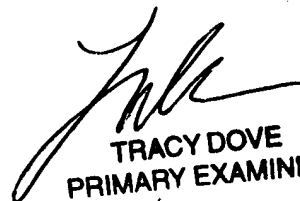
E) Applicant's arguments with respect to the Nshiyama et al. reference have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen O. Chu whose telephone number is (571) 272-5162. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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PRIMARY EXAMINER
4/07